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REMARKS

The Applicant added 8 new claims and responded to the office action dated August 11, 2003 where the Examiner objected to claims 2, 3 and 7. In response to the office action, Applicants respectfully traverse the objection. Claims 2, 3 and 7 remain in the application.

In the office action, the Examiner rejects claim 7 under 35 USC § 102 (a) as being anticipated under U.S. Patent Number 5,535,543 issued to Alexander (Alexander). Claim 7 is not *prima facie* anticipated under Alexander. The Examiner has not cited evidence that each and every limitation of the claim is taught by Alexander as required by MPEP §2131. MPEP §2142 requires that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner states that Alexander discloses that the bag is "made of a woven open mesh polyester..." (See Office Action Page 2) The Examiner is incorrect because Alexander does not teach a "bag composed of a flexible open-mesh fabric..." Instead, Alexander teaches:

"the material forming the bag is thermally insulating..." (See Alexander Col. 4 Lines 36-37). (Emphasis added this author.)

Further, Alexander teaches:

"The present invention is specifically designed to protect fruits and vegetables in the event of a "soft" or "light" freeze." (See Alexander Col. 3 Lines 22). (Emphasis added this author.)

Further, Alexander teaches:

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“Second, in regions experiencing occasional soft freeze conditions but no hard freeze conditions...” (See Alexander Col. 3 Lines 39-40). (Emphasis added this author.)

Further, Alexander teaches:

“Finally, the globular shape of the present invention allows a closer fit than any prior art structure between the bag and spherically- and elliptically-shaped fruits such as oranges, lemons, and grapefruits. The prior art structures disclose pouches, cylinders, tubes and oblong bags or containers. Since a closer fit between the fruit or vegetable translates to more efficient thermal insulation, the globular shape of the present invention affords improved thermal protection.”

(See Alexander Col. 3 Lines 55-62). (Emphasis added this author.)

These statements from Alexander proves that the bag in Alexander cannot be made of an “open-mesh fabric which allows free circulation of air throughout the fruit cluster” because the Alexander bag must be thermally insulating and an open mesh material is incapable of being thermally insulating because it allows the free exchange of air from the exterior of the bag to the interior of the bag.

In contrast, the Examiner cites a passage in Alexander which appears to contradict the thermal necessity of the bag. The passage in Alexander states, “the material is air [and water] permeable...” (See Alexander Col. 4 Lines 36-37). This seemingly contradictory statement does not actually contradict the thermal protection requirement. Whether or not a fabric provides thermal insulation is a matter of degrees. A material which acts as a total barrier to air would provide the best thermal insulation; whereas a fabric which allowed only a little air to penetrate the fabric barrier would still provide insulating qualities. However, an open-mesh fabric as claimed in the present application which “allows free circulation of air...” does not provide any insulation; by allowing the free circulation of air the presently claimed “open-mesh fabric” cannot possibly

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provide the thermal insulation which is expressly and inherently required to practice Alexander. Therefore, the Applicant respectfully submits that the rejection has been traversed, because one of ordinary skill in the art of fruit production would understand that Alexander does not disclose an open mesh bag because an open mesh bag is incapable of providing the thermal insulation required by Alexander to provide frost protection.

If the Examiner disagrees with the Applicant regarding the requirement that the bag in Alexander is thermally insulating or that an open mesh fabric which allows for the free circulation of air does not provide insulation, the Applicant hereby requests an affidavit pursuant to 37 CFR § 1.104(d)(2). When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons. 37 CFR § 1.104(d)(2). (Emphasis added). Therefore, the Applicant hereby requests the Examiner provide an affidavit detailing any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art pursuant to 37 CFR § 1.104(d)(2). When the Applicant receives a clarification of these facts, the Applicant will be better able to adequately respond to the present rejection.

In the office action, the Examiner rejects claims 2 and 3 under 35 USC § 103 (a) as being unpatentable over Alexander. The Examiner is incorrect that it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Alexander with the fabric that has a weight of 86-113 grams per square meter and a cloth count of approximately 13 warps by 10 fills per square centimeter. Specifically, the Examiner states, "It would have

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been obvious, at the time the invention was made, to a person having ordinary skill in the art to provide such range of values of the distance, or an optimum value of the bent diameter, since it has been held that where the general condition of a claim are disclosed in the prior art, discovering the optimum value of a result effective variable involves only routine skill in the art. In re Aller, 105 USPQ 233. It has been held, as well, that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).” While Alexander does disclose that the fabric is water repellent and UV resistant it further requires that the material be selected to provide thermal protection. In contrast, in the present invention the material was selected to allow the free circulation of air and is incapable of providing insulation to the fruit. As a matter of fact, one of ordinary skill in the art of protecting fruit from frost damage would not tinker with a material which has no insulating qualities. Therefore, the Applicant respectfully submits that the rejection has been traversed, because Alexander requires a thermally insulating material and the fabric claimed in the present application cannot provide thermal insulation.

If the Examiner disagrees with the Applicant that a fabric with a weight of 86-113 grams per square meter and a cloth count of approximately 13 warps by 10 fills per square centimeter does not provide thermal insulation, the Applicant hereby requests an affidavit pursuant to 37 CFR § 1.104(d)(2). When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee; and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons. 37 CFR § 1.104(d)(2). Emphasis added. Therefore, the Applicant hereby requests the Examiner provide an affidavit detailing any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the

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teachings of the applied prior art pursuant to 37 CFR § 1.104(d)(2). When the Applicant receives a clarification of these facts, the Applicant will be better able to adequately respond to the present rejection.

On the basis of the above remarks, early consideration of this application and early allowance are respectfully requested.

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Respectfully submitted,
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